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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,615	12/11/2003	Jan Toczycki	14340	8533

7590 02/09/2005
LISA M. SOLTIS
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Glenview, IL 60025

EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,615

Applicant(s)

TOCZYCKI, JAN

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 9 and 11-22 is/are rejected.
- 7) ☒ Claim(s) 4-7 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/11/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's arguments filed 11/18/2004 traversing the restriction requirement mailed 10/25/2004 is persuasive.
2. Claims 1-22 will be examined on the merits.

Drawings

3. The drawings are objected to because the drawings as is do not adequately show the interaction of the diver and hammer arm during operation of the tool. Furthermore, the drawings themselves appear to be informal drawings, which are suitable for examination purpose only. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are

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not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, the wording of the claim is awkward and as such the examiner cannot ascertain the metes and bounds of the claim.

6. In claim 16, the claim recites the limitation "said guide shoe" on line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Savino (US 4,364,507).

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In regard to claims 1-3, Savino discloses the invention as claimed including reciprocating driver blade 26, guide shoe (no number given but part of the body 20), shaft 28 associated with the guide shoe, a hammer assembly 24 which is configured to pivotally strike a driven member 38 and bend it upon reaching the driven position (see Figs 1-6 and C3,L58 – C5,L41).

In regard to claim 11 and as the examiner understands the claim, Savino discloses the invention as claimed including a guide plate on hammer assembly 24 which contacts the driven member (see Figs. 1-6).

In regard to claim 16, Savino discloses the invention as claimed including a housing 20, reciprocating driver blade 26, guide shoe (no number given but part of the body 20), a hammer assembly 24 which is configured to pivotally strike a driven member 38 and bend it upon reaching the driven position an moving in conjunction with the driver assembly (see Figs 1-6 and C3,L58 – C5,L41).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savino.

In regard to claim 12, Savino discloses the invention substantially as claimed except for the use of a bumper pad. However, the examiner takes Official Notice that it is old and well known in the art of tool driving to provide a bumper to cushion an element during operation for the purpose of reducing tool wear. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Savino with a tool bumper for the purpose of reducing tool wear.

In regard to claims 13 and 14, Savino discloses the invention substantially as claimed except for the use of a bumper pad mounted on a guide plate or the hammer arm. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a bumper located on a guide plate or hammer arm, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

In regard to claim 15, Savino discloses the invention substantially as claimed except for the guide plate manufactured from a steel alloy. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a guide plate manufactured from a steel alloy, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of it's suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savino in view of McKee (US 3,279,672).

Savino discloses the invention substantially as claimed except for a spring biased hammer member. However, McKee teaches that it is old and well known in the art of member driving to provide hammer sections 110 and 120 which are biased by a spring 130 for the purpose of efficiently bending a driven member (see Figs 7-9). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Savino with a spring biased hammer member for the purpose of efficiently bending a driven member.

12. Claims 22 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savino in view of Kozyrski (US 6,783,051).

In regard to claim 22, Savino discloses the invention substantially as claimed including a housing 20, reciprocating driver blade 26, guide shoe (no number given but part of the body 20), a hammer assembly 24 which is configured to pivotally strike a driven member 38 and bend it upon reaching the driven position and moving in conjunction with the driver assembly (see Figs 1-6 and C3,L58 – C5,L41). What Savino does not disclose is a tapered shoe section. However, Kozyrski teaches that it is old and well known in the art of member driving to provide a tapered shoe section 54 for the purpose of allowing a tool into a confined space (see Fig. 1 and C3,L48-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Savino with a tapered shoe section as taught by Kozyrski for the purpose of allowing a tool into a confined space.

In regard to claim 17, 18 and 21, Savino discloses the invention substantially as claimed except for the use of a guide shoe attached to the housing, a cylinder and

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cylinder seal. However, Kozyrski teaches that it is old and well known in the art of member driving to provide a cylinder in the form of actuator 14, and a shoe 54, attached to the housing 20, with a driving axis that is less than 90 degrees from the surface of the element for the purpose of pneumatically driving a member in a confined area (see Fig.1 and C3.L12-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Savino with the cylinder and shoe means as taught by Kozyrski for the purpose of pneumatically driving a member in a confined area.

In regard to claim 19 and 20, the modified invention of Savino discloses the invention substantially as claimed as applied claims 16 and 18 above including a cylinder spacer (no number given, but by reference number 100 in Fig. 1 of Kozyrski). What the modified invention of Savino does not disclose is the specific inclusion of a cylinder seal. However, the examiner takes Official Notice that it is old and well known in the art of pneumatic tool driving to provide a cylinder seal that seals the area around the driver for the purpose of ensuring proper compression in the cylinder to ensure reciprocating action of the piston during operation. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified invention of Savino with a cylinder seal for the purpose of ensuring proper compression in the cylinder.

Allowable Subject Matter

13. Claims 4-7 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

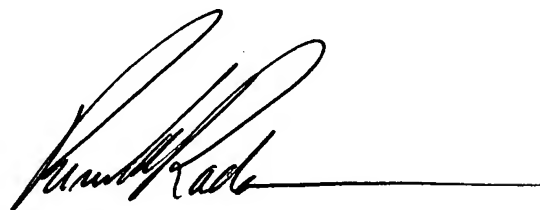
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Romeo, Galer, Olesen, Shkolnikov, Hohner, Dunn, Lorincz and Laubach have been cited to show devices having similar structure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
January 31, 2005

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', followed by a horizontal line.

Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700